

THIS DISPOSTION IS NOT CITABLE
AS PRECEDENT OF THE TTAB

JUNE 27, 1997

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Setnor

Serial No. 74/435,054

Dana Setnor Metzger, Esq. for applicant.

Cynthia H. Mancini, Trademark Examining Attorney, Law Office 109
(Deborah Cohn, Managing Attorney).

Before Seeherman, Hohein and Hairston, Administrative Trademark
Judges.

Opinion by Hohein, Administrative Trademark Judge:

An application has been filed by Eleanor Setnor, d.b.a.
State City Insurance, to register the mark "STATE CITY INSURANCE"
for "insurance agency services in the field of life, casualty,
health and homeowners insurance".¹

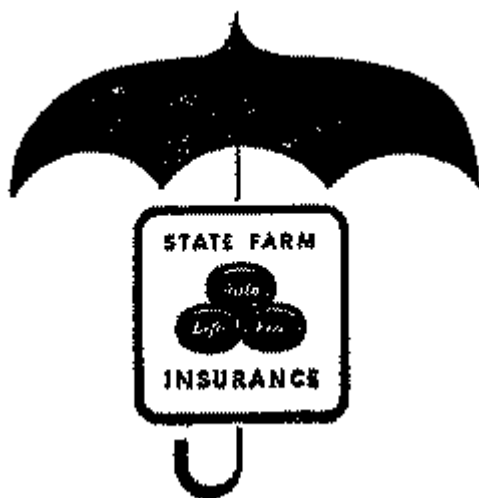
Registration has been finally refused under Section
2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that

¹ Ser. No. 74/435,054, filed on September 14, 1993, which alleges
dates of first use of July 1993. The word "INSURANCE" is disclaimed.

applicant's mark, when applied to her services, so resembles each of the following marks, which are owned by the same registrant for the indicated insurance underwriting services, as to be likely to cause confusion, mistake or deception:

(i) "STATE FARM INSURANCE COMPANIES," which is registered for "underwriting of life, casualty, and fire insurance";²

(ii) "STATE FARM INSURANCE" and design, which is registered as shown below

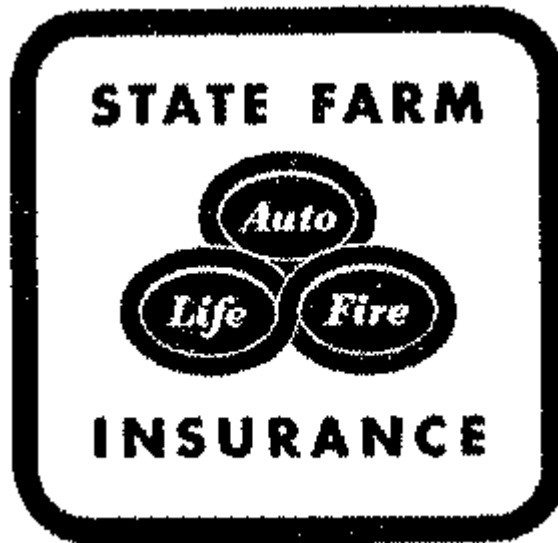


for "underwriting life insurance";³

(iii) "STATE FARM INSURANCE" and design, which is registered as depicted below

² Reg. No. 645,890, issued on May 21, 1957, which sets forth dates of first use of January 1, 1930; second renewal.

³ Reg. No. 721,143, issued on September 5, 1961, which sets forth dates of first use of December 8, 1959; first renewal. The words "Auto," "Life," "Fire" and "INSURANCE" are disclaimed.



for "underwriting life, casualty and fire insurance business";⁴ and

(iv) "STATE FARM INSURANCE" for "underwriting life, casualty and fire insurance".⁵

Applicant has appealed. Briefs have been filed,⁶ but an oral hearing was not requested. We affirm the refusal to register.

⁴ Reg. No. 1,087,834, issued on March 21, 1978, which sets forth dates of first use of February 19, 1953; affidavit §8 accepted. The words "Auto," "Life," "Fire" and "INSURANCE" are disclaimed.

⁵ Reg. No. 1,125,010, issued on September 11, 1979, which sets forth dates of first use of March 1, 1930; affidavit §8 accepted.

⁶ The Examining Attorney, with her brief, has attached a copy of Reg. No. 1,668,793, issued on December 17, 1991, for the mark "LIKE A GOOD NEIGHBOR, STATE FARM IS THERE" for "providing insurance agency services" as support for her contention that "the cited marks must all be considered 'famous' and 'strong'" In particular, the Examining Attorney maintains that the cited marks "have been the subject of famous nationwide advertising campaigns in the print, radio and television media" by registrant which, as "[e]veryone knows," have featured the slogan "LIKE A GOOD NEIGHBOR, STATE FARM IS THERE" as "the tag line of the Registrant's advertisements for at least the last 20 years." In consequence thereof, the Examining Attorney "respectfully requests that the Board permit the examining attorney to insert such evidence on appeal or, in the alternative, that the Board take judicial notice of that registered mark." Furthermore, "[a]s additional evidence that the slogan is famous, the

Turning first to consideration of the respective services, it is clear that applicant's insurance agency services in the field of life, casualty, health and homeowners insurance are closely related to registrant's services of underwriting life, casualty and fire insurance. While an insurance agency, such as applicant, does not actually underwrite the insurance policies it offers, it nevertheless sells policies offered by one or more insurance underwriters. Because such policies are sold either by independent agents like applicant or by those employed directly by the insurance underwriters, there is, as a practical matter, essentially no difference, insofar as the ultimate purchaser of life, casualty, fire or homeowners insurance is

examining attorney notes [in her brief] that the wording is included in a book that lists the 5000 most famous advertising slogans of the twentieth century." However, a copy of the relevant portions of the cited publication, namely, "Urdano, Laurence & Braunstein, Janet, *Every Bite a Delite and Other Slogans*, vii and 180 (Visible Ink Press 1995)," was neither made of record nor does it accompany the Examining Attorney's brief. The Board, moreover, does not take judicial notice of registrations which reside in the Patent and Trademark Office. See *In re Duofold Inc.*, 184 USPQ 638, 640 (TTAB 1974).

Under Trademark Rule 2.142(d), the record in an application should be complete prior to the filing of an appeal and the Board, ordinarily, will not consider additional evidence submitted after an appeal has been filed. Although applicant has not filed a reply brief and, thus, has not raised an objection to consideration of any additional evidence, it is plain that the additional evidence the Examining Attorney seeks to rely upon was available prior to the filing of the appeal in this case. In view thereof, and since in any event the copy of the registration for registrant's slogan and the purported excerpts from a publication listing allegedly well known advertising slogans do not suffice to establish the asserted fame of the cited marks themselves, the additional evidence referred to in the Examining Attorney's brief will not be given further consideration. Whatever fame the cited marks may or may not have accordingly is not a factor bearing upon the issue of likelihood of confusion in this appeal.

concerned, between insurance policies bought through an independent insurance agency and those purchased through the insurance underwriters' own agencies. Applicant, in her brief, concedes that her insurance agency and registrant "are two competing companies that sell the same exact product[s]," namely, life, casualty, and homeowners or fire insurance policies, and the Examining Attorney likewise insists that "the [respective] services are the same." Consequently, if such services were to be sold under the same or similar marks, confusion as to the source of sponsorship thereof would be likely to occur.

Turning next to consideration of the respective marks, we start with the proposition that, "[w]hen marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992), *cert. denied*, 506 U.S. 1034 (1994). Applicant argues, however, that the only words common to her mark and registrant's marks are the terms "STATE" and "INSURANCE". Because, as used in connection with insurance agency services and insurance underwriting services, "it is clear that the two terms 'state' and 'insurance' are weak and commonplace and[,] as such, are entitled to less protection" than arbitrary or otherwise distinctive terms, applicant maintains that confusion is not likely.

While we agree with applicant that it is readily apparent that the term "INSURANCE" is weak in that it is generic for the insurance services rendered by applicant and registrant,

nothing in the record indicates that the term "STATE" is weak either in the sense that it is descriptive of insurance services or that it is commonly used in third-party marks in connection with insurance services which are the same as or similar to those involved herein.⁷ More importantly, nothing in the record suggests that marks which consist of or prominently include the sequential combination of the words "STATE" and "INSURANCE" are weak in the field of insurance agency and underwriting services.

In addition, while we recognize that the word "CITY" in applicant's "STATE CITY INSURANCE" mark and the word "FARM" in registrant's "STATE FARM INSURANCE" marks do not look or sound alike and do not mean the same, we concur with the Examining Attorney that, when considered in their entirety, the respective marks are substantially similar in their structure and

⁷ Applicant, in her brief, refers to a list, which is also set forth in her responses to the first two Office actions, of the following "insurance companies [which] are active and listed in the Florida Underwriter magazine": "State Auto Property & Casualty Insurance Company," "State Auto Mutual Insurance Company" and "State Capital Insurance Company". The Examining Attorney, however, contends that "the information should be given little weight in the overall determination of likelihood of confusion." Among other things, the Examining Attorney observes that the probative value thereof is negligible since applicant not only failed to provide a copy of the pertinent portions of the magazine sought to be relied upon, but, "[m]ost importantly, none of the listed trade names use[s] wording in the same manner as the marks at issue here and the trade names ... carry far different commercial impressions." We agree that a mere list, absent supporting documentation, does not show third-party use of trade names containing the word "STATE". Moreover, even if portions of the magazine containing the listings referred to by applicant had been made of record, we concur with the Examining Attorney that, in light of the very different commercial impressions engendered thereby, the asserted use solely in the State of Florida of the three trade names mentioned by applicant is not persuasive of a finding of no likelihood of confusion, especially in the further absence of information relating to the nature and extent of such use.

engender virtually the same commercial impression.⁸ Each of such marks features, as the initial portion thereof, the arbitrary term "STATE," which is in turn separated from the generic term "INSURANCE" by a single, four-letter word which denotes a geographical place. Applicant's mark, by using the same format as registrant's marks, readily calls to mind such marks. As a result, the marks project essentially the same overall commercial impression. See, e.g., Specialty Brands, Inc. v. Coffee Bean Distributors, Inc., 748 F.2d 669, 223 USPQ 1281, 1283-85 (Fed. Cir. 1984) [mark "SPICE VALLEY" for teas is likely to cause confusion with mark "SPICE ISLANDS" for the same goods due, in large measure, to similarity of commercial impression created by the "'SPICE (place)' format" of the marks].

Furthermore, even while noting the difference between the word "CITY" in applicant's mark and the term "FARM" in registrant's marks, consumers may nevertheless believe that

⁸ Although not argued by applicant, we acknowledge that two of registrant's "STATE FARM INSURANCE" marks contain various design features, along with the words "Auto," "Life" and "Fire," and that a third "STATE FARM INSURANCE" mark ends with the additional word "COMPANIES". However, as to the two marks with design features, we share the Examining Attorney's observation that "the design elements in those ... cited registrations are merely geometric carriers which do not change the overall commercial impression" conveyed by the marks, particularly since the words "Auto," "Life" and "Fire" are generic terms and are displayed in a less prominent manner than the words "STATE FARM INSURANCE". Similarly, inasmuch as the words "STATE FARM INSURANCE," unlike the generic terms "Auto," "Life" and "Fire," would be used by actual and prospective purchasers in asking for and referring to registrant's services, such words dominate over the umbrella design which appears in one of registrant's design marks. Finally, because the word "COMPANIES" merely describes those who market registrant's services, the addition of such word to form the mark "STATE FARM INSURANCE COMPANIES" does not convey a commercial impression different from that projected by the mark "STATE FARM INSURANCE".

applicant's insurance agency, which is situated in the city of Miami, Florida, sells insurance underwritten by registrant which is specially designed to address the insurance needs of urban businesses and residents. For all of the above reasons, we find that contemporaneous use of applicant's "STATE CITY INSURANCE" mark and registrant's "STATE FARM INSURANCE" marks in connection with their respective insurance agency and underwriting services is likely to cause confusion as to source or sponsorship.

Applicant insists, however, that confusion is not likely because purchasers of insurance services are careful and discriminating rather than impulse shoppers. While we do not question applicant's contention that "insurance is a product or service that most consumers investigate cautiously before purchasing," we note, as has the Examining Attorney, that the fact that purchasers may be knowledgeable or sophisticated in a particular field does not necessarily mean that they are knowledgeable or sophisticated in the field of trademarks or immune from confusion as to origin or affiliation. See, e.g., Wincharger Corp. v. Rinco, Inc., 297 F.2d 261, 132 USPQ 289, 292 (CCPA 1962); In re Decombe, 9 USPQ2d 1812, 1814-15 (TTAB 1988); and In re Pellerin Milnor Corp., 221 USPQ 558, 560 (TTAB 1983).

Applicant also asserts that she "has not encountered any confusion by consumers interested in purchasing insurance from her firm" and that, in particular, "[n]ot one person has inquired about whether State City Insurance and State Farm Insurance are related or ... the same" during nearly three years of using her mark in the Miami, Florida area. However, because

the record contains no evidence with respect to the nature and extent of simultaneous use of the marks "STATE CITY INSURANCE" and "STATE FARM INSURANCE" in the same geographical area, the asserted absence of any instances of actual confusion is simply not a meaningful factor. Compare Gillette Canada Inc. v. Ranir Corp., 23 USPQ2d 1768, 1774 (TTAB 1992) with In re General Motors Corp., 23 USPQ2d 1465, 1470-71 (TTAB 1992).

Decision: The refusal under Section 2(d) is affirmed.

E. J. Seeherman

G. D. Hohein

P. T. Hairston
Administrative Trademark Judges,
Trademark Trial and Appeal Board